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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/075,703 | 02/14/2002 | Steven I. Dworetzky | CT-2614-NP | 8374 |

7590

06/27/2003

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EXAMINER

MCKENZIE, THOMAS C

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,703

Applicant(s)

DWORETZKY ET AL.

Examiner

Thomas McKenzie Ph.D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to an application filed on 2/14/02. There are sixteen claims pending. Claims 1-5 are compound claims. Claims 6-11 are use claims. Claims 12-16 are drawn to a pharmacological assay. The application concerns some KCNQ potassium channel activating compounds, uses thereof, and test methods seeking.

2. For Applicants' convenience a copy of a comparative report concerning "reach-through claims" is attached. The Examiner invites the Applicants to consider how these claims are treated at patent offices throughout the world. This appears to be Applicants' intent concerning all compounds working by a specific biological mechanism. The comparative trilateral report on the subject maybe found at http://www.uspto.gov/web/tws/B3b_reachthrough.pdf.

Information Disclosure Statement

3. The information disclosure statement filed 6/11/02 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Copies of the US Patents are with the file but none of the other publications were attached. An unsigned copy of Applicants PTO-1449 is attached.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims parts of 1-11, drawn to oxindole compounds of formula I, page 13, classified in class 548, subclass 361.5.
- II. Claims parts of 1-11, drawn to pyrimidine compounds of formula II, page 17, classified in class 544, subclass 355, among others.
- III. Claims parts of 1, 2, and 5-11, drawn to other activator compounds, classified in class 540, subclass 1, among others.
- IV. Claims 12, 13, and parts of claims 14-16, drawn to two screening methods, classified in class 436, subclass 503.

Claims 3 and 4 link Groups I and II

Claims 1, 2, and 5-11 link Groups I-III

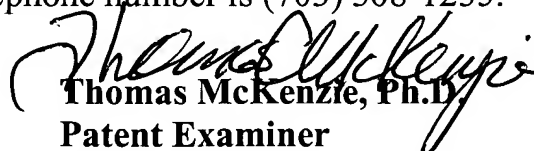
- 5. If applicants elect group III, the other opener or activator compounds, then they must also elect a species of KCNQ potassium channel activator for purposes of classification and examination.
- 6. The inventions are distinct, each from the other because of the following reasons: these multiple claimed compounds of claims 1-5 are chemically non-equivalent and are not art-recognized as sharing the same biological properties. Inventions I-IV have acquired a separate status in the art as shown by their different classification, thus the patent search required for Group I is not co-extensive with that required for Groups II-IV. The basic names of these heterocyclic compounds differ, thus the literature search for these various species

will be divergent. Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is proper.

Should Applicants traverse the restriction requirement on the grounds that the different core rings are not patentably distinguishable, Applicants should identify such evidence now of record or submit any such evidence that shows the groups to be obvious variants. Such evidence may be used in a rejection under 35 USC 103(a) if the Examiner finds any of the Groups unpatentable over the prior art.

Conclusion

7. Please direct any inquiry concerning this communication or earlier communications from the Examiner to Thomas C McKenzie, Ph. D. whose telephone number is (703) 308-9806. The FAX number for before final amendments is (703) 872-9306. The Examiner is available from 8:30 to 5:30, Monday through Friday. If attempts to reach the Examiner by telephone are unsuccessful, you can reach the Examiner's supervisor, Mukund Shah at (703) 308-4716. Please direct general inquiries or any inquiry relating to the status of this application to the receptionist whose telephone number is (703) 308-1235.


Thomas McKenzie, Ph.D.
Patent Examiner
Art Unit 1624

TCMcK
June 26, 2003